

REMARKS/ARGUMENTS

The rejections presented in the final Office Action dated September 10, 2007 (hereinafter Office Action) have been considered. Claims 1-35 remain pending in the application. Claims 19-35, previously withdrawn by the Examiner, have been canceled without prejudice or disclaimer. No claim has been amended or added. Applicant respectfully requests reconsideration and allowance of all pending claims.

Claims 1-18 stand rejected under 35 U.S.C. §112, first paragraph, as failing to comply with the enablement requirement. Applicant respectfully disagrees with the Examiner, and submits that all pending claims comply with the enablement requirement of 35 U.S.C. §112, first paragraph.

In the previous Office Action, and as reiterated in the instant Office Action, the Examiner maintains that Applicant's specification does not describe in such a way as to enable one skilled in the art to understand "how the light beam itself can change its property or how the property of the light beam can change." In the Response to Arguments section of the Office Action, which begins on page 10, it is stated that the Examiner disagrees with Applicant's argument that claim 1 recites an apparatus that effects a change in a property of the emitted light beam. The Examiner maintains that the language of claim 1 must be read to require that the light beam itself changes its property, and that claim 1 does not recite that the apparatus effects such change.

Applicant respectfully maintains that one of ordinary skill in the art would readily comprehend from a reading of Applicant's claims that claims 1-18 do not require that the light beam itself changes its property. Claim 1 is reproduced below:

1. (Original) A stylus for use with a light sensitive user input device, comprising:

a light-emitting device configured to emit a light beam through a tip of the stylus when the tip is not in contact with an input surface of the input device, the light beam having a property that abruptly changes when the tip of the stylus sufficiently contacts the input surface, the abrupt change in the light beam being detectable by the light sensitive user input device.

As Applicant previously argued, one of ordinary skill in the art would readily construe that claim 1 recites “a light-emitting device configured to emit a light beam . . . having a property that abruptly changes when the tip of the stylus sufficiently contacts the input surface . . .”. The quoted language from claim 1 has been simplified by use of an ellipse to emphasize that the light-emitting device is structurally configured in such a way as to effect a change in a property of the emitted light beam when the tip of the stylus sufficiently contacts the input surface.

Contrary to the Examiner’s contention that claim 1 does not recite any mechanism to be used to change the property of the light beam (page 11 of the Office Action), Applicant respectfully asserts that claim 1 clearly recites an apparatus (i.e., a light-emitting device) that is configured to effect a change in a property of the emitted light beam when the tip of the stylus sufficiently contacts the input surface. In its previous response, Applicant made reference to examples of several of such mechanisms described in Applicant’s specification. For example, Applicant’s specification discloses that “[a]ny number of mechanisms can be used to produce the detectable, abrupt change in the light beam upon contact of the stylus with a surface. The type of mechanism can depend on the change being produced” [emphasis added]. Several examples of such mechanisms are disclosed in Applicant’s specification at page 5, line 21 – page 6, line 2 and at page 8, line 24 – page 9, line 4. An objective reading of Applicant’s claims, particularly when read in light of the specification, makes clear that the Examiner’s characterization of the claimed subject matter is in error.

Applicant respectfully submits that the Examiner’s interpretation of claim 1 that requires that the light-beam itself change its property is unsupported and unreasonable. Such an interpretation would require the skilled artisan to disregard common knowledge that a light-beam cannot, by itself, change its property. Such an interpretation would require the skilled artisan to ignore language of claim 1 that makes clear to the reader that the light-emitting device is configured to emit a light beam in a particular manner, namely, in a manner such that a property of the emitted light beam abruptly changes when the tip of the stylus sufficiently contacts the input surface.

For at least these reasons, Applicant respectfully submits that the rejection of claims 1-18 under 35 U.S.C. §112, first paragraph can not be sustained, and requires withdrawal.

In maintaining the rejection of claims 13-18 under 35 U.S.C. §112, first paragraph, the Examiner, on page 11 of the Office Action, contends that the disclosure referenced by Applicant (Applicant's specification, page 10, lines 1-10) in the previous response does not fairly describe an operation of the auxiliary switch for causing a change in the light beam. Applicant respectfully disagrees.

Applicant's specification, at page 10, lines 1-10, describes several operations of the auxiliary switch for causing a change in the light beam. For example, this portion of Applicant's specification teaches that side or auxiliary switch 320 is provided for activating or changing properties of an emitted light beam B. The side switch 320 can be a pressure activated switch that makes or breaks an electrical contact, resulting in a signal. This signal, resulting from actuation of side switch 320, may be a change in the stylus beam such as a change in beam intensity, duty cycle of a modulated beam, frequency of modulation of the beam, color of the beam, polarization of light in the beam, or the on/off condition of the beam, for example.

One of ordinary skill in the art would readily understand from this and other portions of Applicant's specification that the auxiliary switch recited in claims 13-18 may be activated to cause a change in the light beam. For example, and as is clearly described in the excerpts above, the auxiliary switch 320 may be used to effect a detectable change in the stylus beam, such as by a user, to select the same or a different operative function as that selectable by contact of the stylus with the input surface.

The Examiner contends that Applicant's Figure 3 merely shows an auxiliary switch 320 without any connection with other elements. Applicant respectfully reiterates for the Examiner's consideration that, when analyzing whether a particular claim is supported by the disclosure in an application, a patent need not teach, and preferably omits, what is well known in the art. *In re Buchner*, 929 F.2d 660, 661 (Fed. Cir. 1991);

Hybritech, Inc. v. Monoclonal Antibodies, Inc., 802 F.2d 1367, 1384 (Fed. Cir. 1986), *cert. denied*, 480 U.S. 947 (1987); *Lindemann Maschinenfabrik GMBH v. American Hoist & Derrick Co.*, 730 F.2d 1452, 1463 (Fed. Cir. 1984).

In its previous response, Applicant argued that the Examiner had not met the requirements of MPEP 2164.01(a) when rejecting Applicant's claims under 35 U.S.C. §112, first paragraph. The Examiner did not address this omission in the Response to Arguments section of the instant Office Action. As such, the Examiner has yet to satisfy this requirement.

MPEP 2164.01(a) identifies a non-exhaustive list of factors that the Examiner must consider when determining whether there is sufficient evidence to support a determination that a disclosure does not satisfy the enablement requirement and whether any necessary experimentation is "undue." These factors include, but are not limited to: (A) the breadth of the claims; (B) the nature of the invention; (C) the state of the prior art; (D) the level of one of ordinary skill; (E) the level of predictability in the art; (F) the amount of direction provided by the inventor; (G) the existence of working examples; and (H) the quantity of experimentation needed to make or use the invention based on the content of the disclosure.

Neither the previous Office Action nor the instant Office Action provides an indication that the Examiner's conclusion of non-enablement is based on an analysis of the factors set forth in MPEP 2164.01(a). It is improper to conclude that a disclosure is not enabling based on an analysis of only one of the above factors while ignoring one or more of the others. The Examiner's analysis must consider all the evidence related to each of these factors, and any conclusion of nonenablement must be based on the evidence as a whole. *In re Wands*, 858 F.2d 731, 737, 740 (Fed. Cir. 1988).

Because the Examiner has not met the requirements of MPEP 2164.01(a), the enablement rejection of claims 1-18 under 35 U.S.C. §112, first paragraph is without basis and must be withdrawn.

The Examiner maintained the rejection of claims 1, 2, 9, 11-13, 17 and 18 under 35 U.S.C. §102(b) as being anticipated by U.S. Patent No. 4,320,292 to Oikawa et al. (hereinafter "*Oikawa*"). The Examiner, in the Response to Arguments section of the instant Office Action, contends that *Oikawa* explicitly teaches that when the tip 34 of the stylus does not contact the input surface, the light beam from the LD is scattered, and when the tip of the stylus contacts the input surface, the tip 34 is slidably received in the opening 33 to cause the light beam being focused.

Respectfully, this characterization of the *Oikawa* teachings is in error. The portions of *Oikawa* relied on by the Examiner (Fig. 2; col. 3, lines 19-64 and Fig. 3; col. 6, lines 45-64) teach that *Oikawa*'s light pen produces a focused light beam. *Oikawa*, at column 3, lines 28-33, explicitly teaches that the light emitted by the light pen 10 is scattered, not by the light pen, but by an optical scatterer contained in the optical guide channels 11 and 12 of the coordinate input apparatus shown in Figure 1. Contrary to the Examiner's contention, *Oikawa*'s light pen does not produce a scattered light beam when not contacting the input surface.

Respectfully, the portions of *Oikawa* relied on by the Examiner fail to teach, expressly or inherently, that the light emitted by light emitting diode LD is changed, abruptly or otherwise, in the manner recited in Applicant's claim 1. These portions of *Oikawa* also fail to teach, expressly or inherently, that any abrupt change in the light beam, if such were present, is detectable by *Oikawa*'s coordinate input apparatus. Applicant's review of the *Oikawa* reference indicates an absence of express or inherent teaching of at least these features of Applicant's claim 1.

Applicant respectfully submits that *Oikawa* does not teach every element of claim 1, and therefore fails to anticipate Claim 1.

Dependent claims 2, 9, 11-13, 17, and 18, which are dependent from independent claim 1, were also rejected under 35 U.S.C. §102(b) as being anticipated by *Oikawa*. While the Applicant does not acquiesce to the particular rejections to these dependent claims, it is believed that these rejections are now moot in view of the remarks made in

connection with independent claim 1. These dependent claims include all of the limitations of the base claim and any intervening claims, and recite additional features which further distinguish these claims from *Oikawa*. Therefore, dependent claims 2, 9, 11-13, 17, and 18 are also not anticipated by *Oikawa*.

For at least these reasons, Applicant respectfully submits that the rejection of claims 1, 2, 9, 11-13, 17, and 18 as being anticipated by *Oikawa* is not sustainable, the withdrawal of which is respectfully requested.

Claims 3-8, 10, and 14-16 stand rejected under 35 U.S.C. §103(a) as being unpatentable over *Oikawa*.

Establishment of *prima facie* obviousness requires that all claim limitations be taught or suggested in the prior art references. (MPEP § 2143). As discussed above, *Oikawa* fails to teach or suggest a stylus that provides a light beam having a property that abruptly changes when the tip of the stylus sufficiently contacts an input surface of an input device, and that the abrupt change in the light beam is detectable by the light sensitive user input device. Each of claims 3-8, 10, and 14-16 depend from independent claim 1. Independent claim 1 is not obvious for at least the reason that *Oikawa* fails to teach or suggest each and every limitation recited in each claim. Furthermore, while the Applicant does not acquiesce to the particular rejections to these dependent claims, it is believed that these rejections are now moot in view of the remarks made in connection with independent claim 1. These dependent claims include all of the limitations of the base claim and any intervening claims, and recite additional features which further distinguish these claims from *Oikawa*. Moreover, if an independent claim is nonobvious under 35 U.S.C. §103, then any claim depending therefrom is nonobvious. *In re Fine*, 837 F.2d 1071 (Fed. Cir. 1988). Therefore, dependent claims 3-8, 10, and 14-16 are not rendered obvious by *Oikawa*.

Applicant respectfully submits that the Examiner's taking of Official Notice on page 10 of the Office Action is inappropriate. The Examiner's taking of Official Notice is predicated on the legitimacy of the Examiner's lack of enablement rejection of the claims under 35 U.S.C. §112, first paragraph. Applicant's arguments presented above

clearly establish that the Examiner's lack of enablement rejection of the claims under 35 U.S.C. §112, first paragraph is without basis. The Examiner's taking of Official Notice is also without basis and inappropriate.

As such, the Applicant respectfully requests withdrawal of the §103(a) rejection of claims 3-8, 10, and 14-16 and notification that these claims are in condition for allowance.

It is to be understood that Applicant does not acquiesce to the Examiner's characterization of the asserted art or Applicant's claimed subject matter, nor of the Examiner's application of the asserted art or combinations thereof to Applicant's claimed subject matter. Moreover, Applicant does not acquiesce to any explicit or implicit statements or conclusions by the Examiner concerning what would have been obvious to one of ordinary skill in the art, obvious design choices, alternative equivalent arrangements, common knowledge at the time of Applicant's invention, officially noticed facts, and the like. Applicant respectfully submits that a detailed discussion of each of the Examiner's rejections beyond that provided above is not necessary, in view of the clear absence of teaching and suggestion of various features recited in Applicant's pending claims. Applicant reserves the right to address in detail the Examiner's characterizations, conclusions, and rejections in future prosecution.

Applicant respectfully submits that claims 1-18 are in condition for allowance and requests early indication of the same.

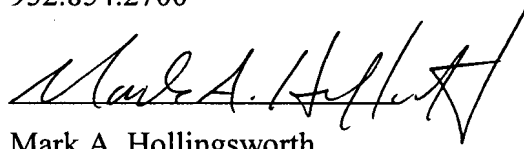
Authorization is given to charge Deposit Account No. 50-3581 (MMM.064.A1) any necessary fees for this filing. If the Examiner believes it necessary or helpful, the Examiner is invited to contact the undersigned attorney to discuss any issues related to this case.

Respectfully submitted,

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Date: November 8, 2007

By:

A handwritten signature in black ink, appearing to read "Mark A. Hollingsworth", written over a horizontal line.

Mark A. Hollingsworth
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